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10/046,257

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EXAMINER

ZIMMERMAN, MATTHEW E

ART UNIT

PAPER NUMBER

3625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/046,257	<b>Applicant(s)</b> MATSUMOTO, MUTSUMI	
	<b>Examiner</b> MATTHEW ZIMMERMAN	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,9 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

***Introduction***

1. Claims 1,4,7,9 and 12-17 are pending in the instant application.
2. Claims 1,4,7,9 and 12-16 are amended.
3. Claim 17 is new.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 4, 13-14, and 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order to qualify as a statutory process the claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. In addition, mere field of use limitations or limitations reciting insignificant extra-solution activity will not transform an unpatentable process into a patentable one as the machine or transformation must impose meaningful limits on the scope of the claim. Thus, merely reciting a specific machine or a particular transformation of a specific article is an insignificant step (e.g., data gathering, outputting, displaying, receiving, and the like) and will not move to make an unpatentable process patentable.

Although the present invention recites the use of a "delivery goods management apparatus", this is just the nominal recitation of a physical structure and fails to satisfy the statutory requirements. Likewise, claims 13-14 recite a "method in a data processing system" and a "method of operating a data processing system", and these are just a nominal recitation of a physical structure and fails to satisfy the statutory requirements. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Furthermore, the claims fail to contain a transformation of a particular article to a different state or

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thing. As such, the present invention is directed towards non-statutory subject matter and is rejected under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 4, 7, 9, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno (Patent Application Publication No. 2002/0035515 A1) in view of Saki et al. (U.S. Patent No. 7,174,307).**

Moreno claims priority to provisional application 60/218,400 filed on July 14, 2000. Said provisional application provides 35 U.S.C. 112, first paragraph support for paragraphs 0001 – 0081 of the Moreno reference. Said provisional application does not provide 35 U.S.C. 112, first paragraph support for paragraphs 0082 - 0112 of the Moreno reference, therefore those sections of Moreno do not qualify as prior art.

Referring to Claim 1, Moreno discloses a method of and apparatus for managing delivery goods when directly delivering goods from a deliverer (Moreno: paragraph 0053, “Depending upon the vendor providing the goods/services, delivery may be obtained by a designated deliverer, by a commercial deliverer, or by another entity.”) to

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a location associated with a recipient (Moreno: paragraph 0053, “Next, the process continues with delivering the goods/service to the locker...” ) comprising:

- Receiving, at a delivery goods management apparatus (Moreno: paragraph 0064, “the storage unit”), which includes at least a data storage containing information regarding a deliverer of goods and a recipient (Moreno: paragraph 0049, “the database 108 stores customer and vendor information”) and can also be accessed by the deliverer (Moreno: paragraph 0072) and recipient (Moreno: paragraph 73), a request to confirm reception of delivery goods entered by a deliverer when a recipient of the delivery goods from the location is absent approves or rejects delivery of the goods by the deliverer to the location (Moreno: paragraphs 0064 through 0065, “Upon arriving at the storage unit, the carrier appropriately provides the designated tracking code, access code, or other required verifications...”);
- Extracting recipient information from the storage of the delivery goods management apparatus, where the storage stores the recipient information corresponding to information related to the request to confirm reception of the delivery goods (Moreno: paragraph 0066, “Upon delivering /picking-up the goods and securing the locker, the system then notifies the server...”); and
- Transmitting a notification, from the delivery goods management apparatus, to said recipient of confirmation request information based on the recipient information while the recipient is absent from the location (Moreno: paragraph 0066), said method further comprising:

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- Further storing information for a deliverer corresponding to delivery goods identification information in said storage unit and receiving the delivery goods identification information and reception approval information entered by said recipient (Moreno: paragraph 0067);
- Extracting the deliverer information relevant to the delivery goods identification information from said storage unit (Moreno: paragraph 0067); and
- Notifying said deliverer of the reception approval information based on the deliverer information (Moreno: paragraph 0067).

The Examiner notes, the claims require the recipient to confirm as to whether the recipient approves or rejects delivery. The claims are written utilizing alternative language, and accordingly, once a positively recited step is satisfied (i.e., either approving or rejecting), the method as a whole is satisfied - regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Moreno fails to explicitly teach the features of “wherein the request includes a message to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location” and “so that the deliverer delivers the goods to the location associated with the recipient when a result of the reception approval/refusal indicates an approval of the delivery of the goods by the recipient”. Sakai, in an analogous art, explicitly teaches “wherein the request includes a message to confirm as to whether the recipient approves or rejects delivery of the goods by the deliverer to the location” (Sakai: column 7 lines 46-67 and column 8 lines 1-5; where the flag is the same thing as a notification of approval/rejection) and “so that the deliverer delivers the

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goods to the location associated with the recipient when a result of the reception approval/refusal indicates an approval of the delivery of the goods by the recipient” (Sakai: column 7 lines 46-67 and column 8 lines 1-5; "Rejection flag denotes a flag...showing that a gift is to be sent from a sender to a receiver is rejected before the gift is actually delivered to the receiver"). The advantage of such features is that they ensure the proper delivery of items, thereby increasing the accuracy of the method. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine these features taught by Sakai to Moreno in order to increase the accuracy of the method.

Referring to Claim 4, Moreno teaches “further storing information for a client corresponding to the delivery goods information in said storage, and extracting the delivery goods information and client information relevant to the delivery goods identification information, from said storage unit” (Moreno: paragraph 0067). Moreno fails to explicitly teach “notifying said client of the reception approval/refusal information based on the client information”. Sakai, in an analogous art, explicitly teaches this feature in column 7 lines 46-67 and column 8 lines 1-5, where approval/refusal information is stored as a flag with the client information. The advantage of such a feature is again to improve the accuracy of the deliveries thereby increasing the accuracy of the method. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine this feature taught by Sakai to Moreno in order to improve the accuracy of the method.



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Referring to Claims 7, 9, and 12-16, these claims recite a “delivery goods management apparatus”, a “computer readable storage medium”, a “method in a data processing system”, and a “method of operating a data processing system” taught by Moreno (see Moreno abstract). Claims 7, 9, and 12-16 further recite limitations already addressed by the rejections of claims 1 and 4; therefore the same rejections apply to these claims. Examiner notes that claim 16 recites a broadened method of claim 1.

Referring to Claim 17, the combination teaches a method, comprising:

- transmitting a request from a deliverer to a potential recipient who is not present at a location of a good to be delivered (Moreno: paragraphs 0064 through 0065, “Upon arriving at the storage unit, the carrier appropriately provides the designated tracking code, access code, or other required verifications...”), the request requesting for transmission of an affirmative response that the potential recipient ordered the good to be delivered (Sakai: column 7 lines 46-67 and column 8 lines 1-5; where the flag is the same thing as a notification of approval/rejection);
- delivering, by the deliverer, of the good for the potential recipient when the potential recipient is not present at the location if the potential recipient transmits the affirmative response in return to the request (Sakai: column 7 lines 46-67 and column 8 lines 1-5; “Rejection flag denotes a flag...showing that a gift is to be sent from a sender to a receiver is rejected before the gift is actually delivered to the receiver”).

***Response to Arguments***

8. Applicant's arguments filed 11/19/2008 have been fully considered but they are not persuasive.

9. Rejection of Claims 1, 4, 13-14 and 16 under 35 U.S.C. §101

10. Applicant respectfully submits that a rejection of claims 1, 4, 13 and 14 under 35 U.S.C. § 101 has been previously withdrawn as acknowledged by the non-final Office Action mailed August, 2007 on page 9. The Examiner stated that the Applicant's arguments on page 6 of the remarks submitted June 13, 2007 had been "persuasive" and the rejection was withdrawn.

The Examiner respectfully submits that the previous rejection under 35 U.S.C. §101 that Applicant refers to is directed to a different rationale than the current rejection. The present rejection is being made according to the recent circuit court opinion (*In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

11. Applicant respectfully submits while the Office Action alleges that there is "no transformation of any physical object...", during the recitation of the present invention, there is transformation made to the delivery goods identification information DB, recited in claim 1 as "storage." Moreover, amended claim 1 now recites "deliverer delivers the goods to the location associated with the recipient," thus there is a physical transformation of a physical object, i.e. "goods," which are delivered "to the location associated with the recipient." Thus, since there is transformation to the "storage" as a result of "transmitting a notification" to a recipient and "further storing information for a deliverer," and transformation of "the goods" whereby the "deliverer delivers the goods

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to the location associated with the recipient," claim 1 recites statutory subject matter.

Similar amendments have been made to claims 13-14 and 16.

The Examiner respectfully disagrees. Delivering "goods to the location associated with the recipient" is not tied to a particular machine or apparatus, and even if it were, would likely constitute mere insignificant extra-solution activity. Additionally, the goods are not transformed into a different state or thing because they remain the same throughout their journey to the recipient. While they are moved from one location to another, the claims lack a underlying physical transformation of the goods.

The Examiner notes that the other recited steps such as extracting, transmitting, storing, and notifying are also not presently tied to a particular machine or apparatus. While the claims recite a "goods management apparatus", the apparatus is merely used for insignificant extra-solution activity. For example, in the phrase "extracting recipient information from the storage of the delivery goods management apparatus" the apparatus containing the storage is merely the location of the repository where the information is extracted and does not in any way affect the step of "extracting".

12. Rejection of Claims 1, 4, 7, 9, and 12-16 under 35 U.S.C. §103

13. Applicant respectfully submits that while claim 1 recites "a request to confirm reception of delivery goods entered by a deliverer," in Sakai, the request is not entered "by a deliverer" but is rather initiated after a gift sender attempts to send a gift to a receiver.

The Examiner respectfully disagrees. Moreno teaches that upon arriving at the storage unit, the carrier (deliverer) confirms deposit of the goods by entering relevant

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information (e.g., a tracking code, and other data) into the goods management apparatus (Moreno: paragraph 0064 through 0065).

14. Applicant respectfully submits that Sakai notes "when a receiver is absent at a gift delivery date, the receiver must request redelivery of the gift to the distributor of the gift." (See column 1, lines 62-64). In other words, Sakai attempts to eliminate gift returns to the original distributor or store. However, claim 1 is related to eliminating the need for redelivery of delivery goods during receiver absence through "a request to confirm reception of the goods entered by a deliverer" whereby "the deliverer delivers the goods to the location associated with the recipient" after "an approval" is issued by the receiver of the goods. Sakai actually teaches away from claim 1 in that it explicitly attempts to eliminate delivery of gifts which are unwanted by eliminating any delivery attempts altogether. (See column 1, line 66 - column 2, line 3) Claim 1 is directed toward eliminating unsuccessful delivery attempts, "when a recipient of the delivery goods from the location is absent" while Sakai discusses eliminating delivery attempts altogether.

The Examiner respectfully disagrees. The cited portion of Saki which refers to redelivery of goods when the receiver is absent is discussed in the background portion of the specification as a shortcoming of previous inventions. The actual Saki disclosure does not explain what happens when a receiver is absent. However, it is beside the point because Moreno was, and continues to be, used to teach delivery of goods when a receiver is absent the location of delivery (Moreno: paragraph 0072 teaches delivery of the goods into the storage unit at 4:23pm and paragraph 0073 teaches the receiver

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arrives at the storage unit at 6:15pm and acquires the goods). Therefore, the Examiner is not persuaded by Applicant's arguments.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW ZIMMERMAN whose telephone number is (571)270-5278. The examiner can normally be reached on Mon-Thu 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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